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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/873,601 06/12/97 NOLAN

G A-63915/DJB/

EXAMINER

HM12/0324

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FOUR EMBARCADERO CENTER
SUITE 3400
SAN FRANCISCO CA 94111-4187

RICIGLIANO, J

ART UNIT	PAPER NUMBER
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1618

12

DATE MAILED:

03/24/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/873,601

Applicant(s)
NOLAN

Examiner
Joseph W. Ricigliano Ph. D.

Group Art Unit
1618



☒ Responsive to communication(s) filed on Dec 31, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-42 is/are pending in the application.

Of the above, claim(s) 9-26 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-8 and 27-42 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Please Note: In an effort to enhance communication with our customers and reduce processing time, Group 1640 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses. The Fax number is 703-305-3704. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. If you have any questions or suggestions please contact Donald E. Adams, Ph.D., Supervisory Patent Examiner at Donald.Adams@uspto.gov or 703-308-0570. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

1. This action is responsive to applicants' amendment of 12/31/98.
2. Applicants have amended the claims to recite species not previously set forth in the original claims. In view of this amendment the examiner sets forth the following election of species prior to any further action on the merits.

Election/Restriction

3. Applicants have previously elected group I, claims 1-8, all of which are generic to group I for examination on the merits in paper number 7.
4. As amended this application contains claims directed to patentably distinct species of the claimed invention set forth in subgroups A-C

A) species of substrate

- i) linear scaffolds, claim 28
- ii) circular scaffolds, claim 29
- iii) branched scaffolds, claim 30

The species differ with respect to their structures. Because the species differ with respect to the structure of the substrate and the search required for each is distinct, restriction for examination purposes as indicated is proper

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B) species of scaffold fusion partners

- i) presentation structures, claim 33
- ii) targeting sequences, claim 34
- iii) rescue sequences, claim 35
- iv) stability sequences, 36
- v) linker sequences, claim 37

The species differ with respect to the property fusion partner supplies to the scaffold. Because the species differ with respect to the scaffold fusion partners and the search required for each is distinct, restriction for examination purposes as indicated is proper

Currently, claims 31 is generic to subgroup B and will be examined on merits with any of species Bi-Bv to the extent of the species elected.

C) species of enzyme fusion partners

- i) presentation structures, claim 38
- ii) targeting sequences, claim 39
- iii) rescue sequences, claim 40
- iv) stability sequences, claim 41
- v) linker sequences, claim 42

The species differ with respect to the property the fusion partner supplies to the enzyme. Because the invention differ with respect to the enzyme fusion partners and the search required for each is distinct, restriction for examination purposes as indicated is proper

Currently, claim 32 is generic to subgroup C and will be examined on the merits with any of species Ci-Cv to the extent of the species elected.

A proper election of species requires a selection from each of subgroups A-C.

Currently claims 1-8 and 27 are generic to group I and will be examined with any of the species elected.

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Applicants are required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

Applicants are advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicants will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicants must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicants should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicants are advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

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Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Applicants are also reminded that a 1 - month (not less than 30 days) shortened statutory period will be set for response when a written requirement is made without an action on the merits. This period may be extended under the provisions of 37 CFR 1.136(a). Such action will not be an "action on the merits" for purposes of the second action final program, see MPEP 809.02(a).


It is noted that applicants' arguments will be considered pending election of a species for further prosecution on the merits.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph W. Ricigliano Ph. D. whose telephone number is (703) 308-9346. The examiner can be reached on Monday through Thursday from 7:00 A.M. to 5:30 P.M.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the group receptionist whose telephone number is (703) 308-0196.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald E. Adams Ph. D., can be reached at (703) 308-0570.

Joseph W. Ricigliano Ph. D.


PONNATHAPURA ACHUTAMURTHY
PRIMARY EXAMINER
GROUP 1800